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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/804,039

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Hidefumi Yoshida

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10/02/2006

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EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,039

Applicant(s)

YOSHIDA, HIDEFUMI

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

In the Amendment filed on 07/19/06, the following have occurred: Claims 1 and 6-8 were amended; claims 4, 9 and 10 were cancelled; claims 1-3 and 5-8 are pending, and claims 1-3 and 5-8 stand rejected in this office action. Further, the amendment has necessitated the withdrawal of the 35 USC 112, 1<sup>st</sup> paragraph rejection given in the last office action

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al (Shwartz hereinafter, US PAT pub. #: 2001/0044787).

**Re claims 1, 7-8.** A transaction supporting apparatus for use by an intermediary agent in supporting payment of a transaction made between a buyer and a seller, said apparatus comprising: issuing means for issuing a membership number to the buyer upon a first purchase of any product using the intermediary agent (see pg.5 paras 0097); sending means (i.e., (the internet) "In some preferred embodiments, the secure private agent executes the payment instructions of the consumer, and arranges to pay the merchant against a private credit balance

between the trusted third party and the consumer, a commercial credit card authorization, or other conventional payment mechanism which can be effected via the internet," see pg 2 paras 0023, also see pg 5 paras 0081) **for sending the membership number of the buyer to a delivery service agent who delivers the product to the buyer; receiving means for receiving credit card information about a credit card account of the buyer (see pg 5 paras 0095, also see pg.9 paras 0142) via the delivery service agent upon delivery of the product to the buyer, only once the first time the buyer uses the intermediary agent for payment for a purchase; registering means for registering credit card account information received via the delivery service agent, together with the membership number of the buyer (see pg 5 paras 0083-0086); payment information notifying means for notifying the buyer of payment information including information about a bank account of the seller into which the buyer is requested to transfer money by other means than the registered credit card account before a specified deadline expires (see pg 11, paras 0196), payment confirming means for confirming whether the requested money transfer has been made (see pg 11, paras 0191-0196) by the other means than the registered credit card account to the seller's bank account by the specified deadline, and charging means (i.e., see fig.1, element 22) for charging by the intermediary agent for the transaction via the credit card account identified from the credit card information registered together with the membership number of the buyer, only if said payment confirming means finds that the requested money**

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transfer to the seller's bank account by the other means than the registered credit card account has not been made by the deadline.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz.

**Re claim 2.** Schwartz does not explicitly disclose the transaction supporting apparatus according to claim 1, further comprising means for sending to the buyer a reminder message which reminds the buyer of payment when the payment confirming means confirms that payment has not been made by the deadline, said charging means charges for the transaction via the credit card when a given period described in the reminder message has expired. However, It is old and well known in the art that when a seller does not receive a payment within a period of time specified in the sale contract, the seller would send a reminder message to the buyer and request that the buyer sends the appropriate payment. Thus, if the buyer fails to pay within a deadline, then it is commonsensible and obvious that the seller would charge for the transaction using the buyer's credit information on file. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of

Shwartz in light of what is well known in the art for seller to obtain payment that is due to the seller.

5. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shwartz in view of Keith Lamond

(Keith hereinafter: Credit Card Transactions Real World and Online, see

[http://www.virtualschool.edu/mon/ElectronicProperty/klamond/credit\\_card.htm](http://www.virtualschool.edu/mon/ElectronicProperty/klamond/credit_card.htm), 1996, pgs1-17).

**Re Claim 3:** Shwartz discloses a transaction supporting apparatus supporting payment of a transaction made between a buyer and a seller (see abstract).

Shwartz does not disclose the transaction supporting apparatus, further comprising means for remitting to the seller an amount obtained by subtracting a given service fee from an amount paid by the buyer. Keith discloses a virtual payment system comprising means for remitting to the seller (i.e., a merchant, pg 7) an amount obtained by subtracting a given service fee (i.e., transaction fees, see pg 7) from an amount paid by the buyer (see pg7, #7). Thus, it would have been obvious for one of ordinary skill in the art to modify Shwartz to include Keith's teaching to allow credit card processing intermediary to collect fee for the services rendered for the use of their infrastructure.

6. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shwartz in view of Martinez (US PAT 5,208,446).

**Re Claim 6:** Shwartz does not explicitly disclose the transaction supporting apparatus, further comprising means for requesting the delivery service agent to

deliver a product purchased by the buyer and notifying the delivery service agent of information about the buyer said information about the buyer including an address of a delivery destination. However, Martinez discloses: The transaction supporting apparatus, further comprising means for requesting the delivery service agent to deliver a product purchased by the buyer and notifying the delivery service agent of information about the buyer (see col.2, lines 45-47) said information about the buyer including an address of a delivery destination (see col.2, lines 45-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shwartz by adapting the teaching of Martinez to give the buyer the option of paying for goods on delivery of said goods.

7. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shwartz in view of Lalonde (U.S PAT: 5,477,040).

**Re claim 5:** Shwartz discloses the transaction supporting apparatus further comprising means for initiating a money transfer from a specified bank account of the buyer to the bank account of the seller (i.e., the account is settled, see paras 0198) wherein said charging means charges for the transaction via the credit card account (see fig.1 element 22). Shwartz does not explicitly disclose charging for the transaction if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer. However, Lalonde discloses a method for making charge transaction further comprising means for initiating a money transfer from a

specified bank account of the buyer to the bank account of the seller (i.e., periodic settlement of accounts as by electronic funds transfer, col 11, line 55-67). Lalonde further discloses a charging means wherein said charging means charges for the transaction via the credit card account if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer (i.e., credit limit means, col. 10, line 31) (col. 10, lines 31-50). Thus, it would have been obvious to one of ordinary skill in the art to modify Shwartz with the credit limit means of Lalonde to ensure that sellers can still receive payments in case the buyer's primary account does not have a balance sufficient for the payment to be made by the deadline.

#### ***Response to Arguments***

8. Applicant's arguments filed 07/19/06 have been fully considered but they are not persuasive. The applicant argues in substance that the cited prior art of record, Shwartz, fails to disclose "registering....credit card information received via the delivery service agent, together with the membership number of the buyer" as recited in claim 1. Contrary to the applicant's assertion, Shwartz explicitly discloses the registering means for registering the credit card information.....(i.e., The registration process using the internet will now be disclosed in further detail. The consumer 10 enters the World Wide Web site 40 of the secure private agent 16. At the World Wide Web site 40 he is presented with the terms and conditions which must be agreed to in order to become a registered client of the secure private agent 16. After agreeing with the terms and conditions the consumer is



requested to provide personal details, including his credit card number. The personal details are passed to the secure private agent 16, employing either the channel 24 or the telephone channel 38. They are saved in a secure database system residing in a server 42 of the back office logic 44, see pg 5 paras 0083-0087). The applicant further argues that Shwartz describes sending a confirmation number confirming a transaction to a consumer without any mention of "a bank account of the seller" as recited in claim 1. Contrary to the applicant's assertion, Shwartz makes this disclosure (i.e., The electronic commerce site 66 sends confirmation information, optionally with a reference number. The confirmation is intercepted by the back-end gateway 50, and is relayed to the consumer 10, see pg 11, paras 0196. Inherently, the payment amount is resolved against the consumer's account (debit the consumer's account), and the said payment amount is credited to the seller's bank account).

The applicant further argues that neither Shwartz nor Lamond discloses "remitting to the seller an amount obtained by subtracting a given service fee from an amount paid by the buyer." It is true that Shwartz does not disclose the transaction supporting apparatus, further comprising means for remitting to the seller an amount obtained by subtracting a given service fee from an amount paid by the buyer. However, Keith Lamond discloses a virtual payment system comprising means for remitting to the seller (i.e., a merchant, pg 7) an amount

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obtained by subtracting a given service fee (i.e., transaction fees, see pg 7) from an amount paid by the buyer (see pg7, #7).

Lastly, the applicant further argues that none of the references cited by the examiner, taken individually or in combination, recites "charging means charges for the transaction via the credit card account if said payment confirming means finds that said bank account of the buyer does not have a balance sufficient for the payment to be made by the buyer" (claim 5, lines 3-5). Contrary to the applicant's assertion, Schwartz explicitly discloses charging means for charging for the transaction (see paras pg 11, paras 0198, also see fig.1 element 22).

Shwartz does not explicitly disclose charging for the transaction if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer. However, Lalonde explicitly discloses a charging means wherein said charging means charges for the transaction via the credit card account if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer (i.e., The credit limit means 108 in operation, alters the charge card selection made by the charge card selection processor 102, in accordance with the credit limits on the card holder's charge cards and the card holder's accounts with the separate charge card issuers as maintained in the card holder accounts means ..... Should a credit authorization be refused by a preferred

charge card issuer, the preference is switched to the next preferred charge card issuer until authorization is obtained. Refusal of authorization is noted on the card holder's next statement. In addition, all merchant overrides of preferred charge cards, and or direct transactions with the charge card issuers to bypass selection of a preferred charge, are noted on the periodic statements, see col.10 lines 31-55).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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